

REMARKS

Thorough examination of the application is sincerely appreciated.

According to the Office Action, claims 9, 11 and 15 were rejected under 35 USC 112, second paragraph for minor informalities. In response, claims 9, 11 and 15 are amended to correct the lack of antecedent basis. It is believed that the claims now fully comply with 35 USC 112, and withdrawal of the rejections is respectfully requested.

Further according to the Office Action, claims 1-3, 5-7, 9-11, 13-16, 18 and 19 were rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 6,148,288 (hereinafter "Park") in view of U.S. Patent US 5,892,848 (hereinafter "Nishiwaki") and further in view of US Patent 4,918,523 (hereinafter "Simon").

In response, the rejections are respectfully traversed as lacking sufficient factual support and failing to establish a prima facie case of obviousness in accordance with the established cases and statutory law.

In the Office Action, the Examiner asserted that Park teaches Applicant's feature of "generating quality information which indicates distortion of the object" as recited in claim 1. For such disclosure, the examiner relied on Park's Fig. (col. ?) 3, lines 44-47.

Applicant's representative has carefully reviewed Park as relied upon in the Office Action. It is respectfully submitted that nowhere does Park teach or suggest the above feature of Applicant's invention.

Park merely discloses a side information having quantization step size information and quantization bit information allotted to each band. Please see col. 3, lines 44-47 and Fig. 3 of Park. First, nowhere does Park teach or suggest that the side information is "generated" as in Applicant's claim 1. Second, Park's side information is not analogous or equivalent to

Applicant's quality information. More specifically, Park's quantization step size is not analogous or equivalent to Applicant's quality information. Please refer to Applicant's specification for some examples of quality information.

If the examiner still believes otherwise and maintains the rejection based on the same prior art rejections, he is respectfully requested 1) to **specifically point out** where such a disclosure on correspondence between quantization step size and Applicant's claimed quality information can be found in Park; 2) to provide a personal affidavit stating the facts within his personal knowledge that Park's quantization step size is analogous or equivalent to Applicant's claimed quality information; or 3) to provide an affidavit from a skilled artisan stating the same. In the absence of such evidence for Applicant's review and analysis, the rejections can't be properly maintained.

With respect to Nishiwaki and Simon, the examiner merely extracted features from those references while completely disregarding the individual objectives of each patent. Nishiwaki only teaches quantization bits in the packet header, but fails to disclose that quantization bits are analogous or equivalent to Applicant's quality information. Similarly, Simon's feature is simply extracted from the patent and added to Park and Nishiwaki.

It is respectfully submitted that the Examiner failed to establish a *prima facie* case of obviousness. The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Analyzing the references according to the above roadmap, first the examiner offered an unsupported, conclusory remark that “it would have been obvious ...” It is not clear what the basis was for such an assertion. There is absolutely no motivation or suggestion to combine the references, except on the basis of the impermissible hindsight and knowledge gleaned from Applicants’ invention. Such a practice is prohibited by the applicable law. Picking and choosing elements from various references, while disregarding each reference as a whole, is clearly prohibited by the courts and cannot possibly be sanctioned by the USPTO.

Second, the examiner failed to indicate a reasonable expectation of success and whether the prior art references are combinable.

Third, Park, Nishiwaki and Simon, even when combined, do not teach all of the Applicant’s features as recited in claim 1. Please see the above discussion on Park’s side information vs. Applicant’s quality information. The Applicant’s features are not taught or suggested in the prior art references, and their combination is deficient in teaching or suggesting all the claim limitations.

Therefore, the cited references, separately or in combination, fail to render obvious the claimed invention, because at least one of the above-identified criteria is not met. The claimed invention, according to claim 1, is thus distinguishable over the cited references.

At least for the above reasons, Applicant submits that the rejection of claim 1 has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

Analysis of independent claims 9-11, 13, 15 and 19 is analogous to the one of claim 1, as presented hereinabove. To avoid repetition, claims 9-11, 13, 15 and 19 will not be discussed in detail with the understanding that they are patentable at least for the same reasons as claim 1. Applicants, therefore, respectfully request withdrawal of the rejection and allowance of claims 9-11, 13, 15 and 19

Claims 2, 3, 5-7, 14, 16 and 18 depend from independent claims, which have been shown to be allowable over the prior art references. Accordingly, claims 2, 3, 5-7, 14, 16 and 18 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 2, 3, 5-7, 14, 16 and 18 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

With respect to claims 4 and 8, the examiner merely relied on Shin (US Patent 6,493,387) and Girod (US Patent 5,809,139) for the proposition of features unique to those claims only. Since the examiner did not rely on Shin or Girod to cure the deficiencies of the Park, Nishiwaki, and Simon patents in claim 1 and without conceding any statements or waiving any arguments in the Office Action concerning claims 4 and 8, it is respectfully submitted that claims 4 and 8 are allowable at least by virtue of their dependency from claim 1. Applicant submits that the reason for the rejection of claims 4 and 8 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claim.

With respect to claims 12 and 17, it is respectfully submitted that the combination of Park and Nishiwaki is deficient in rendering obvious the claimed invention as explained above with

reference to Applicant's claim 1. Applicant submits that the reason for the rejection of claims 12 and 17 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claim.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited. However, if for any reason this application is not considered to be in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the number listed below prior to issuing a further Action.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

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